

RESPONSE TO FINAL OFFICE ACTION
U.S. Serial No. 10/636,066

REMARKS

Assignee and the undersigned attorney thank Examiner Duong for review of this patent application and for the allowance of claims 1-8. Assignee respectfully requests reconsideration of claims 9-14.

The Action rejected claims 9 and 10 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0197537 to *Newman et al.* ("*Newman*"). The Action rejected claims 11-14 under 35 U.S.C. § 103(a) as being unpatentable over *Newman* in view of U.S. Patent No. 6,150,905 to *Nishijima* ("*Nishijima*").

Claim Rejections

Claims 9-13

The Action rejected claims 9 and 10 as anticipated by *Newman* and rejected claims 11-13 as being obvious in view of the combination of *Newman* and *Nishijima*. Claim 9 is reproduced below:

9. A molded electronic component designed to comply with preset operating characteristics comprising a substrate for holding passive circuit elements and a material molded about the substrate and circuit elements, wherein the interaction of the material and the circuit elements forms a circuit causing the component to perform at the preset operating characteristics.

Contrary to the Examiner's assertions, *Newman* does not anticipate claim 9 because it fails to teach each and every element of claim 9.

The Examiner asserts that *Newman* teaches all of the elements of claim 9 in a single paragraph on page 2 of the Action. With all due respect, Assignee believes the Examiner has misunderstood and misstated the teachings of *Newman* in rejecting claim 9. Specifically,

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Newman does not teach or suggest any of the recited elements of claim 9, including (a) a substrate for holding passive circuit elements, (b) a material molded about the substrate and circuit elements, and (c) wherein the interaction of the molded material and the circuit elements forms a circuit causing the component to perform at the preset operating characteristics.

Referring now to the Examiner's discussion of *Newman*, reference numerals 10 and 16 of *Newman* refer to a receiver circuit 10 and an amplifier and demodulation circuit 16. Both are shown in Fig. 1 and described at paragraph 0028 of *Newman*. There is no teaching or suggestion that circuits 10 and 16 are "passive circuit elements" as recited by claim 9. The Action also refers to a substrate 100. However, the substrate does not hold any circuit elements or circuits 10 and 16 as the Examiner states, but rather the substrate is merely a substrate upon which the Barium Cadmium Tantalum (BCT) compounds of the *Newman* invention may be grown as thin films. This is explained clearly in paragraph 0037 of *Newman* (*see also* Abstract; claims 28 and 30). In fact, the reference to the numeral "100" discussed with regard to the substrate is not a reference numeral corresponding to any drawings, but merely a reference to the crystalline direction of the exemplary MgO substrate upon which the BCT compound is grown (*see* paragraph 0037).

The BCT films may be grown on a substrate in some embodiments of *Newman*, but *Newman* does not teach or suggest any "material molded about the substrate and circuit elements," as recited in claim 9. The BCT material of *Newman* is nothing more than an elemental compound material that has a high dielectric constant and may be used generally in

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electrical circuits. It is neither molded about a substrate nor about circuit elements to form a circuit as recited in claim 9. In short, *Newman* teaches only a compound and method of growing that compound as a thin film on a substrate. There is nothing in *Newman* to teach or suggest a material molded about passive circuit elements on a substrate such that the molded material and circuit elements form a circuit causing the molded electronic component to perform at preset operating characteristics, as recited in claim 9.

Because *Newman* fails to teach or suggest each and every element of claim 9, the Examiner should withdraw the rejection of claim 9 under 35 U.S.C. § 102(b), and claim 9 should be allowed. Inasmuch as claims 10-13 depend from and thereby include the limitations of independent claim 9, claims 10-13 should also be allowed for at least such dependencies.

Claim 10 should be allowed for the additional reason that *Newman* does not teach or suggest that “the material forms a housing that is marked with indicia to indicate an operating characteristic associated with the component,” as recited by claim 10. The word “housing” appears nowhere in *Newman*, and none of the drawings of *Newman* depict a housing. There is absolutely no support for the Examiner’s assertions that the BCT compounds disclosed by *Newman* could be used as housings, or that any indicia could be marked on these compounds, as recited in claim 10. Thus, the Examiner should withdraw the § 102 rejection of claim 10, and claim 10 should be allowed for this additional reason.

Claim 14

The Action rejected claim 14 as being obvious in view of the combination of *Newman* and *Nishijima*. Claim 14 is reproduced below:

14. A method for making an encapsulated electronic component comprising:
- (a) designing a circuit to operate at a first set of operating characteristics;
 - (b) encapsulating the circuit in a particular material;
 - (c) retesting the encapsulated circuit to determine a second set of operating characteristics;
 - (d) determining whether the second set of operating characteristics matches a predetermined set of operating characteristics for the encapsulated component; and
 - (e) modifying, if necessary, the design of the circuit to account for the effect of the encapsulating material so that the overall encapsulated component performs at the predetermined set of operating characteristics.

In an identical manner to the previous office action (which rejected claim 14 as obvious in view of a different reference combined with *Nishijima*), the Action merely states: “Regarding claim 14, the structure as mentioned above can performed [sic] the method claim.” However, claim 14 does not recite a method performed by the structure recited in any of claims 9-13, but rather claim 14 recites a method of making an encapsulated electronic component. *Newman* and *Nishijima*, alone or in combination, do not teach or suggest the subject matter recited in claim 14.

For example, *Newman* and *Nishijima* do not teach or suggest at least any of the following as recited in claim 14:

- retesting the encapsulated circuit to determine a second set of operating characteristics;

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- determining whether the second set of operating characteristics matches a predetermined set of operating characteristics for the encapsulated component;
- modifying, if necessary, the design of the circuit to account for the effect of the encapsulating material so that the overall encapsulated component performs at the predetermined set of operating characteristics.

In fact, *Newman* does not describe or suggest testing circuits in any manner or encapsulation of circuits at all. For these reasons, the Examiner should withdraw the rejection of claim 14 under 35 U.S.C. § 103, and claim 14 should be allowed.

The foregoing is submitted as a full and complete response to the Final Office Action mailed June 28, 2005. Assignee submits that claims 9-14 are allowable for at least the reasons set forth above, and allowance of these claims is respectfully requested. The preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability. If the Examiner believes there are any issues that can be resolved via a telephone conference, or there are any informalities that can be corrected by an Examiner's amendment, please call Geoffrey Gavin at (404) 815-6046.

Respectfully submitted,



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